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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 16 2000

In re the application of)
FRIEDRICH et al.)
Serial No.: 09/235,242)
Filed: January 22, 1999)
For: PREPARATION OF β-ALKOXYNITRILES)

Group No. 1626

Examiner: L. Stockton

8/18/00

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REPLY BRIEF UNDER 37 CFR 1193b1

Sir:

In addition to those cited in the principal Brief on Appeal, the following legal authorities are cited in this reply brief:

Loctite Corp v. Ultraseal Ltd., 781 F.2d 861, 874, 228 USPQ 90,99(Fed. Cir. 1985)

In re Dow Chemical Co. 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531-32 (Fed. Cir. 1988)

In re Antonie, 559 F. 2d 618, 620, 195 USPQ 6,8 (CCPA 1977)

MPEP §2142, second paragraph

This reply brief is considered to be necessitated by several misstatements in the Examiner's Answer of July 5, 2000.

In the Examiner's response to applicants' arguments in the brief on appeal (see page 5, first paragraph of the Examiner's Answer), she has stated that Green teaches running the first step of the here claimed process continuously with removal of the alcohol " and not the catalyst" by distillation, referring to column 4, lines 30-37, of that reference. The portion referred to by

the Examiner actually refers to the process described in the immediately preceding two paragraphs, which is the reverse reaction. That very teaching of an equilibrium reaction which can be carried out in either direction, in the presence of the here relevant catalyst depending on the conditions used, forms part of the background of the prior art relied on by appellants to establish unobviousness for their overall process.

In the explication of the rejection, the Examiner has stated that "there is no indication of an interaction between steps of such a type that would lead one of ordinary skill in the art to doubt that a substitution of alternative steps known to the art could be made." (Examiner's Answer, page 4, third paragraph). That statement is explicitly rebutted by those teachings in the prior art referred to in applicants' principal brief, i.e., the Bruson article; Green at column 4, lines 12-16 and 25-32, and Example 14; O'Lenick at column 1, line 50- 55; and Sullivan at column 7, line 12-26.

Although applicants' have refrained from using the almost cliché expression "hindsight reconstruction of the references" in their previous arguments, it should be apparent from their principle brief and the comments presented here, in reply to the Examiner's erroneous statements in the Examiner's Answer, that the rejection before the Board in this case is paradigmatic of impermissible hindsight. See merely for example, *Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1480-81, 1 USPQ 1241, 1246 (Fed. Cir. 1986), cert. denied, 482 U.S. 909(1987); and Loctite Corp v. Ultraseal Ltd., 781 F.2d 861, 874, 228 USPQ 90,99(Fed. Cir. 1985).* See also MPEP §2142, second paragraph. In other words, the Examiner has retained the rejection set forth in the first office action only by continued reliance on the bits and pieces of those references favorable to her position and ignoring all of the evidence of record that would have led one of ordinary skill in the relevant art away from the here claimed invention, in the first instance, and certainly would have led to a prediction of its

lack of success rather than the success demonstrated in the working examples in this specification. *In re Dow Chemical Co. 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531-32 (Fed. Cir. 1988); In re Antonie, 559 F. 2d 618, 620, 195 USPQ 6,8 (CCPA 1977); In re Rinehart, 531 F.2d 1048, 1053-54, 189 USPQ 143,148 (CCPA 1976).*

For the foregoing reasons, in addition to those set forth in the principal brief, it is respectfully submitted that reversal of the Examiner's rejection of all claims is in order.

REMARKS

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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